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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|-------------------|
| 10/551,772 | 10/03/2005 | Ezio Bombardelli | 2503-1173 | 5728 |
| 466 | 7590 | 06/14/2007 | EXAMINER | |
| YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202 | | | | KATAKAM, SUDHAKAR |
| ART UNIT | | PAPER NUMBER | | |
| 1621 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|------------------------------|--------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/551,772 | BOMBARDELLI ET AL. |
| | Examiner Sudhakar Katakam | Art Unit 1621 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 May 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10 is/are pending in the application.
 - 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) Claim(s) 1-7 is/are allowed.
- 6) Claim(s) 11-13 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Status of the Application

1. Receipt of Applicant's Remarks and Arguments filed on 9th May 2007 is acknowledged. Applicants amended the claims 1, 6 and 13 and accordingly the previous 112 rejection has been withdrawn. However, a new 112 rejection has been applied to the claim 13 because it contains the new matter. The arguments for the 103(a) rejection are not found persuasive and as such, the following rejection has been maintained. The claims 11-13 remain rejected and all claims are pending.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claim recite the compound "p-pivaloyloxyferutinine", but the specification does not appear to provide support for said compound. The instant specification discloses the compounds p-pivaloyloxybenzoic acid (III) and p-pivaloylferutine (IV). There is no disclosure of the added compound "p-pivaloyloxyferutinine", to claim 13. This is new matter.

Response to Arguments

4. Applicant's arguments filed on 9th May 2007 have been fully considered but they are not persuasive.

The thrust of the applicants' arguments is that **Tamemoto et al** fails to disclose or suggest a possible cosmetic composition preparation of a ferutinine.

The examiner does not find this argument persuasive. The examiner agrees that the **Tamemoto et al** reference does not disclose applicants' method of preparing a cosmetic composition. However, **Tamemoto et al** teach a folk medicine for the treatment of skin diseases and wounds, and the medicine is isolated from the *Ferula kuhistanica*. **Tamemoto et al** also showed that one of the extracted compound from *Ferula kuhistanica* is ferutinine [see Introduction and Results/Discussion in page 763]. The word "cosmetic" is a skin related, and its composition falls within the scope of the compositions treating the skin related diseases. Please also note that the preparation of a composition for a known compounds with a suitable excipients is known in the art. So, adding the effective amount of *Ferula* spp extract or ferutine or p-pivaloyloxyferutine to an acceptable excipient to make a cosmetic composition is obvious.

Therefore, the examiner finds that it would have been obvious to a person of ordinary skill in the art at the time of the invention was made, extract the ferutinine from genus *Ferula*, and make a cosmetic composition using an acceptable excipient, with a reasonable expectation of success.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 11-13 are again rejected under 35 U.S.C. 103(a) as being unpatentable over **Tamemoto et al** (Phytochemistry, 763-767, 58, 2001) for the reasons of record.

8. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no even, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Allowed Subject Matter

9. Claims 1-7 are allowable.

The following is a statement of reasons for the indication of allowable subject matter: the closest prior art (J.Org.Chem. USSR, 28, 10, 1992, 1666-1673) fails to teach or fairly suggest esterification of jaeschkenadiol with p-pivaloylbenzoic acid to make p-pivaloyferutinine and then its hydrolysis to make ferutinine.

Correspondence

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Katakam

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